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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,537	01/23/2004	Atsushi Tomita	009683-496	2578

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EXAMINER
KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
2622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>01/23/04</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1.   Regarding the IDS of 01/23/04 said to have been acknowledged in and included with the last Office action, that IDS is now included (any confusion or inconvenience caused by the Office is regretted).

2.   Regarding claim 10, applicant correctly noted that that has not been rejected. Actually, although the claim was not expressly addressed in the body of the action, the was in fact included on the PTOL-326 form as being rejected. The examiner inadvertently neglected to address that claim in the Official action. That claim is in fact rejected below, and as a result of the previous omission, this action has not been made final.

The examiner regrets prolonging prosecution.

3.   Applicant's arguments filed on 12/19/06 regarding the rejection of claim 12 based on Bullock et al. has been fully considered but they are not persuasive. That rejection accordingly still applies and is repeated below from the last Office action. Applicant's arguments are addressed in the context of the rejection.

The other newly presented rejections are in response to applicant's amendment.

4.   Claim 12 stands rejected under 35 U.S.C. 102(b) as being anticipated by Bullock et al.

Reviewing Figs. 1 and 4 of Bullock, he transmits print-out data (e.g. coupons, advertisements: col. 2 lines 50-57) with video broadcast data (col. 2 lines 44-50), as a first step. A cue signal is also transmitted therewith (e.g. col. 59-62; Fig. 3) for associating print-out of

print-out data by a printer 58 at the receiver 40. Applicant argues that Bullock does not disclose or suggest printing out of the information when the separated video information is reproduced.

However, the claim only recites transmitting a control signal "*associated with print-out of said print-out data*" which does not require that the control data actually trigger or initiate printing.

Moreover, the claims only say that the control signal links the timing at which the video information is reproduced.

Bullock prints out the print-out data based on a cue signal that is transmitted (regardless that it's done by an FM carrier) and subsequently received by receiver 42, as a composite signal with the video signal. When the particular commercial is broadcast (which inherently includes reception and display, that being the intention of broadcasting), the cue signal links the timing of the coupon (i.e. the print-out data) with the video signal (i.e. the commercial) because it is related to the commercial. The user can then initiate the printing, but the claim does not require that the printing is prompted by the control signal (note also col. 7 lines 11-34). As for claim 13, the video information is a sequence of frames (characterizing a video broadcast), and the control section (governed by microprocessor 50) includes data to (at least) prohibit printing (col. 8 lines 6-20).

5.   Claims 1-3, 5-7, 10-14 and 17 are now rejected under 35 U.S.C. 102(b) as being anticipated by Arima (made of record in the last Office action).

The system of Arima (noting particularly Figs. 1, 2, 6, 8 and 16) involves digitally broadcasting programming (e.g. a cooking program section [0003]) and print-out information

(e.g. sections 0093], [0095]). A control signal (data in the header: e.g. Fig. 2) associated wit the

print-out of the print-out data is transmitted together as a single digital stream and received by

stage 1B (Fig. 1). The control data links the timing of the print-out data and the display of the

video information (e.g. sections [0095], [0101]), thereby meeting claim 12.

As for claim 13, the control data also includes a signal prohibition of the print-out data

(noting signal 8A in Fig. 8).

As for claims 1 and 11 the image forming apparatus 1 of Arima includes stage 1B which

covers the claimed acquirement section and reception section since it acquires/receives from a

predetermined access target (i.e. broadcast station) a program that contains displayable

programming and print-out data from the broadcast provider. (section [0080]). The composite

data stream is disassembled to provide separate data for printing (by stage 1E) and displaying

(stage 1D), the separation also, done by stage 1B. Storage unit 1C contains the to-be printed-out

data, and commanding section1F or preprogrammed CPU 1A issues a command for printing out

the print-out data stored in the memory at a predetermined time of reproduction (presentation) of

the video program (sections [0082], [0095], [0101]).

As for claim 2, a system can identify control signals used for prohibiting printing (i.e. the

claims disabled second state), and can in turn reactivate the printer upon receiving a print

enabling control signal (Figs. 12-15).

Regarding claim 3, the transition section involves the CPU and receiver working together

as a transition arrangement to identify the different control signals responsible for controlling the

different (on/off) states of the printer.

As for claim 14, Arima includes a CPU for executing program instructions involving the

decoding a disassembly of the composite broadcast stream, and in turn providing the printing

and/or display of the programming and print-out data. Arima also points out that alternative

software-run processing can be used (section [0147]).

As for claim 17, Arima also points out that the printing control data can be transmitted in

a different broadcast from that of the program (e.g. section [0133]).

As for claim 5, the first and second notification sections read on the receiver/CPU that

recognize that the print-out data is detected, and the control signal that carries out the automatic

printing thereof. As discussed above, the system can print out the data at the time of

reproduction/presentation of the program (which print data can be from storage), the output

(printing) section 1E providing the hard copy upon being notified of the control signal.

Considering claim 6, the printer can be disabled and consequently reactivated upon

getting the "print OK" control signal after the "do not print" control signal, as also discussed

previously.

As was also explained previously, the disabled-to-activated state operations qualify as

transition notifications that are recognized by the image forming apparatus A of Arima, thereby

meeting claim 7.

As for claim 10, Arima also includes a printing prohibition section for preventing the

printing from being carried out (e.g. Fig. 14 data 14F).

6.   Claims 4, 9 and 15 are now rejected under 35 U.S.C. 103(a) as being unpatentable over

Arima in view of Johnson et al. (also made of record n the last Office action).

It is noted that Arima includes a memory 1C for storing printable data. He does not give

any detail on its filling or erasing, although one of ordinary skill in the art realizes that its

capacity has an upper limit and must therefore be erased at times.

Reviewing Johnson, he also incorporates a printer with his television receiver (noting

particularly Figs. 1-3), wherein receiver/decoder (noting Figs. 2 and 3) includes an image

forming apparatus (the television display, not shown, or printer 50), wherein the cable

subscriber's unit (corresponding to the claimed reception section) receives broadcasted signals

comprising print-out data (element 52) and control data for printing out the data (e.g. col. 5 lines

40-63). Microprocessor 60 detects the print-out data and the control data, RAM 48 can store the

print-out data, and printer 50 in turn prints out the coupon based on the received control data.

It would have been obvious to one of ordinary skill in the art to use the CPU of Arima the

way Johnson uses his microcomputer 60: to detect the end of signal transmission, and the data is

erased from RAM 48 (col. 5 lines 48-56 and col. 10 lines 55-60).

7.   Claims 8, 15 and 16 are now rejected under 35 U.S.C. 103(a) as being unpatentable over

Arima in view of Summers (also made of record in the last Office action).

Summers points out that the broadcast and desired print-out data can be transmitted at

different predetermined times (col. 7 lines 63-68). It would therefore have been obvious to one

of ordinary skill in the art to ensure that a determination is made by the receiver of the timing

relationship of when to receive/display the programming and when to print out the data relative

to the programming, so determined by each individual user.

8.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Victor R. Kostak whose telephone number is (571) 272-7348.

The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David W. Ometz can be reached on (571) 272-7593. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any response to this action should be mailed to:

        Commissioner of Patents and Trademarks
        P.O. Box 1450
        Alexandria, Virginia 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is (703) 308-HELP.

Victor R. Kostak
Primary Examiner
Art Unit 2622

VRK